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PATENT APPLICATION

ATTORNEY DOCKET NO. 10005868-1IN THE
 UNITED STATES PATENT AND TRADEMARK OFFICEInventor(s): Marc P. Schuyler

Confirmation No.: 1881

Application No.: 09/703,459Examiner: Jean D. JanvierFiling Date: October 31, 2000

Group Art Unit: 3622

Title: **METHOD FOR TARGETING PROMOTIONS TO INDIVIDUAL ASSOCIATED WITH A VEHICLE**

Mail Stop Appeal Brief - Patents
 Commissioner For Patents
 PO Box 1450
 Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEFTransmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 1/31/2007.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Marc P. Schuyler

Serial No.: 09/703,459

Filed: October 31, 2000

For: METHOD FOR TARGETING
PROMOTIONS TO INDIVIDUAL
ASSOCIATED WITH A VEHICLE

Patent Examiner: Jean D. Janvier

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APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed on January 31, 2007, Appellant submits this Reply Brief.

Appellant appeals the decision of the Examiner finally rejecting all of the claims pending in the present application, namely claims 1-11. Appellant's Notice of Appeal was filed on January 27, 2005.

Appellant requests allowance of the claims at issue.

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**RECEIVED
CENTRAL FAX CENTER****PATENT****MAR 15 2007****I. REAL PARTY IN INTEREST**

Hewlett-Packard Company is the real party in interest in the subject application, by virtue of an assignment from the inventor Marc P. Schuyler to Hewlett-Packard Company (recorded on July 9, 2001 at reel 011968, frame 0121).

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are currently known that will directly affect, be directly affected by, or have a bearing on the decision to be rendered by the Board of Patent Appeals and Interferences in the present appeal.

III. STATUS OF CLAIMS

Claims 1-11 are pending in the application.

Claims 1-11 stand rejected under 35 U.S.C. §103(a). Each rejected claim is being appealed.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection in this matter.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a method of targeting promotions to an individual in a vehicle, where the vehicle includes an on-board system having sensors from which a maintenance event can be detected (see specification, page 3, lines 30-34). The method includes detecting a vehicle maintenance event by digitally interrogating the on-board system and identifying whether the vehicle maintenance condition meets predetermined maintenance criteria (see specification, page 3, line 34 to page 4, line 3). If a maintenance event is detected, an

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identification of that event is wirelessly transmitted to a remote computer, i.e. at the nearest vehicle dealership (see specification, page 4, lines 3-5). The method includes generating a promotion associated with the vehicle maintenance event and providing the promotion to the individual associated with the particular vehicle having the maintenance event (see specification, page 4, lines 5-8). To help target the promotion, the dealership receiving the vehicle identification and vehicle maintenance event information stores data of an association between the individual and the particular vehicle (e.g., in a computer database, indexed by vehicle identification number) and uses the vehicle identification to associate the vehicle maintenance event with the individual and routes the promotion to the individual (see specification, page 4, lines 8-17).

Dependent claim 3 recites wherein generating a promotion includes obtaining service discount coupon permissions for a plurality of service providers, across multiple geographies (see specification, page 21, lines 1-10). Dependent claim 3 also recites filtering the service providers based on type of vehicle maintenance service and geographic vicinity to the individual (see specification, page 21, lines 1-35) and generating and transmitting at least one coupon to an address associated with the individual in response to the filtering (see specification, page 21, lines 1-35).

Dependent claim 7 recites wherein the vehicle has an on-board computer system and a vehicle user display screen (see specification, page 7, lines 15-28) and sending the promotion to the individual includes sending an electronic message to the on-board computer system for the vehicle which causes the computer system to visually display the promotion for the user (see specification, page 4, lines 8-17 and page 22, lines 8-11).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-6 and 8-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mezger et al. (U.S. Patent No. 5,781,871) in view of Scroggie et al. (WO 97/23838).
2. Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Mezger et al. (U.S. Patent No. 5,781,871) in view of Park (U.S. Patent No. 5,627,549).

VII. ARGUMENT***§103(a) REJECTION OF CLAIMS 1-2, 4-6 AND 8-11 OVER MEZGER IN VIEW OF SCROGGIE***

The Examiner rejected claims 1-2, 4-6 and 8-11 as being unpatentable under 35 U.S.C. §103(a) over *Mezger* in view of *Scroggie*. (Final Office Action, Pg. 5). The Examiner is also contending that claims 1-2, 4-6, and 8-11 are further rejected in view of “well known materials” disclosed in the final office action. (Examiner’s Answer, pp. 12-17; Final Office Action, pp. 9-12).

The “well known materials” do not teach or suggest “detecting a maintenance event” and “generating a promotion associated with the vehicle maintenance event” as recited in independent claim 1. At best, the “well know materials” disclose the sending of promotional materials based on the manufacturer’s recommendations or to encourage a user to return to the dealer’s service location for scheduled service maintenance. To determine when the promotional materials should be sent, the service provider “keeps record of the last odometer reader of the customer’s car during the car purchase or service and estimates after a certain period of time

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when the car is due" for maintenance "in accordance with the car manufacturer's recommendations requiring that the car receive a service maintenance based on the number of miles thus far recorded in order to keep the car in good operating condition." (Final Office Action, pp. 9-10).

However, the "well known materials" do not teach or suggest sending promotional materials based on the detection of a vehicle maintenance event in the specific car. It only guesses based on the odometer reading of the car. Thus, any promotional materials that do overlap with the need for vehicle repairs would be largely coincidental or not specific to that car. The repairs would then mostly be accomplished too early because the user received the promotional material too early when a vehicle maintenance event is non-existent, or too late, because the user received the promotional material too late when a vehicle maintenance event has already existed for a longer than desired period of time. There is no indication that the guessed mileage will match the actual mileage. Furthermore, even if the mileage actually matches the guessed mileage based on the odometer, the actual mileage may not match a need for servicing because the actual mileage does not indicate if the specific car needs servicing, but rather only when the automobile manufacturer recommends servicing in general.

Consequently, if the user receives the promotional material too early, the user will have wasted money unnecessarily servicing his vehicle. If the user receives the promotional material too late, the user will have generated excess wear and tear on his vehicle, which could potentially lead to other repair costs because the user waited too long to service his vehicle.

In contrast, in the present invention, the user receives promotional materials in direct response to when a vehicle maintenance event is detected for the user's specific car. (Specification, Pg. 20, ln. 20 – Pg. 21, ln. 10; Figs. 1, 2 and 8). Thus, the user receives the

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promotional material at an appropriate time in conjunction with a vehicle maintenance event. This can reduce the unnecessary expenditure of money and time on servicing the vehicle before it needs service and also reduce the amount of time the user waits to service the vehicle after the vehicle needs to be service.

The Examiner also admits that *Mezger* does not expressly disclose "detecting a maintenance event" and "generating a promotion associated with the vehicle maintenance event" as recited in independent claim 1. (Final Office Action, Pg. 6, Ins. 4-5 and Examiner's Answer, Pg. 4, Ins. 6-7).

Furthermore, *Scroggie* does not teach or suggest "detecting a maintenance event" and "generating a promotion associated with the vehicle maintenance event" as recited in independent claim 1. *Scroggie* merely discloses sending coupons to members who log into their system. It does not disclose that the coupons are associated with an automobile, that they are tied to a vehicle maintenance event, or that they are automatically distributed to the user.

Also, there is no motivation for combining *Mezger* with *Scroggie*, and the "well known materials." In fact, the "well known materials" teaches away from *Mezger*. *Mezger* seeks to avoid the erroneous establishment of diagnostic thresholds. However, the Examiner stated that the motivation for "well-known materials" is to encourage

the customer or vehicle 11 owner to return to the dealer's shop or local service provided location to have vehicle 11 serviced or repaired for the current problem associated with the triggering maintenance event, or for other regular service maintenance, such as motor or transmission oil change, timing belt replacement or tune-up, etc., that is due or past due based on the vehicle 11 odometer current reading and the manufacturer's criteria or recommendations and for other potential faulty operations or defects revealed as a result of a meticulous testing or inspection conducted at the workshop or dealer's shop or service provider's location.

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(Examiner's Response, Pg. 15). The "regular service maintenance" and service based on "odometer current reading" is established by the auto manufacturer using limited data, which is what *Mezger* seeks to avoid. (Col. 1, lns. 24 - 41). Thus, while "well known materials" encourages repairing the vehicle based on unreliable manufacturer data, *Mezger* encourages establishing better diagnostic thresholds. *Scroggie* does not deal with automobiles, requires user action before a coupon is generated, and is not generated in response to a maintenance event for an automobile.

Therefore, there is no motivation to combine *Mezger* with *Scroggie* and the "well known materials."

Appellant believes that its response was complete in the appeal brief given that the Final Office Action first stated that "Claims 1-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mezger et al. (hereinafter *Mezger*), U.S. Patent No. 5,781,871 in view of *Scroggie*, WO 97/23838." (Final Office Action, Pg. 5). Only after discussing *Mezger* and *Scroggie* did the Examiner insert two paragraphs regarding the "well known materials" nearly 5 pages later. It was unclear if the "well known materials" was an extension of *Scroggie*, independent of *Scroggie*, or if it was merely background as to the motivation to combine *Scroggie* with *Mezger*.

Since the discussion of "well known materials" came after *Scroggie*, Appellant believes the "well known materials" was either an extension of *Scroggie* or the motivation for combining *Scroggie* with *Mezger* in the appeal brief. Appellant's statements in the appeal brief goes to both issues.

Appellant stated in the appeal brief that "Scroggie does not contemplate generating purchase incentive offers associated with a vehicle maintenance event" and "Scroggie, on the

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other hand, does not mention ‘vehicle or vehicle maintenance event.’” (Appeal Brief, pp. 8 and 10). If the “well known materials” was an extension of *Scroggie*, both “well known materials” and *Scroggie* do not disclose “generating purchase incentive offers associated with a vehicle maintenance event.” If, however, the Examiner meant for “well known materials” to serve as background for motivation for combining *Scroggie* with *Mezger*, *Scroggie* does not mention “vehicle or maintenance event.”

Thus, Appellant adequately addressed “well known materials” in Appellant’s Appeal Brief.

Appellant has addressed the issue regarding the “well known materials” in this Reply Brief with regards to the patentability of Claim 1 over *Mezger* in view of *Scroggie* and the “well known materials.”

§103(a) REJECTION OF CLAIM 3 OVER MEZGER IN VIEW OF SCROGGIE

The Examiner rejected claim 3 as being unpatentable under 35 U.S.C. §103(a) over *Mezger* in view of *Scroggie*. The Examiner is also contending that claim 3 is further rejected in view of “well known materials” disclosed in the final office action. (Examiner’s Answer, pp. 15-17; Final Office Action, pp. 9-12).

The Examiner admits that *Mezger* does not expressly disclose “filtering the service providers based on type of vehicle maintenance service and geographic vicinity to the individual” as recited in dependent claim 3. (Examiner’s Answer, Pg. 4, lns. 6-15; Final Office Action, Pg. 6, lns. 4-13).

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Scroggie also do not disclose “filtering the service providers based on type of vehicle maintenance service and geographic vicinity to the individual.” Although *Scroggie* may display coupons from stores that correspond to the user’s Zip Code, it does not display coupons based on the type of vehicle maintenance service. (Pg. 10, lns. 19-26). In contrast, in the present invention, the promotional material is generated based not only on the geographic vicinity to the individual, but also the type of vehicle maintenance service.

The “well known materials” also do not teach or suggest “filtering the service providers based on type of vehicle maintenance service and geographic vicinity to the individual.” In the “well known materials,” the individual service providers themselves send the promotional material. (Final Office Action, Pg. 9-10). An individual service provider does not filter “service providers” since: (1) an individual service provider does not want to distribute promotional materials for competing service providers; and (2) the individual service provider does not care if other service providers send promotional materials that are not related to the vehicle maintenance issue and the geographic location of the individual. In contrast, the present invention can be used in conjunction with multiple service providers in order to provide better service coverage for the individual.

Furthermore, there is no indication that the “well known materials” filter “service providers” based on the type of vehicle maintenance. In the “well known materials,” the type of vehicle maintenance is based on an estimate of an odometer reading of the vehicle or the time of the year. The odometer reading is not the actual odometer reading, but merely an estimate of what the odometer reading should be based on a length of time. Thus, the filtering of “service providers” is not based on a vehicle maintenance issue that has been detected in the car but rather only on theoretical estimates.

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In the present invention, the type of vehicle maintenance as recited in claim 1, which claim 3 depends from, is the type of vehicle maintenance that is detected "when the vehicle maintenance condition meets predetermined maintenance criteria" after "digitally interrogating the on-board system of the vehicle." Thus, the present inventions filters "service providers" based on an actual detected type of vehicle maintenance.

Hence, the Examiner improperly asserts that the deficiency in *Mezger* is remedied by *Scroggie* and the "well known materials." *Mezger*, *Scroggie*, and the "well known materials" taken individually, or in combination, fail to disclose, teach or suggest all of the limitations of claim 3. Therefore, claim 3 is patentable over the cited references.

§103(a) REJECTION OF CLAIM 7 OVER MEZGER IN VIEW OF PARK

The Examiner rejected claim 7 as being unpatentable under 35 U.S.C. §103(a) over *Mezger* in view of *Park*.

The Examiner admits that *Mezger* does not explicitly disclose "the vehicle has an on-board computer system and a vehicle user display screen; and sending the promotion to the individual includes sending an electronic message to the on-board computer system for the vehicle which causes the computer system to visually display the promotion for the user" as recited in dependent claim 7. (Examiner's Answer, Pg. 10, Ins. 3-5; Final Office Action, Pg. 12, Ins. 13-17).

Park does not teach or suggest "sending the promotion to the individual includes sending an electronic message to the on-board computer system for the vehicle which causes the computer system to visually display the promotion for the user." In order to receive promotional

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material, a user has to push button 102f when an advertisement is audibly emitted to the user. The promotional material would be the promotional material from the audio advertisement that the user hears. (Col. 6, lns. 41-54; Fig. 3). Since the audio advertisement frequently changes, the promotional material would also frequently change.

In contrast, in the present invention, the promotional material is not associated with an audio advertisement, but rather with a vehicle maintenance event. The transmitted promotional material that is visually displayed is generated when the present invention is "generating a promotion associated with the vehicle maintenance event" as recited in independent claim 1. Thus, the promotion may change in response to maintenance events that are detected as opposed to frequently changing audio advertisements.

Furthermore, in the present invention, the user does not have to push a button to receive the promotional material, but instead displays the promotional material in response to a maintenance event. Thus, the user does not have to acknowledge or perform any other action to indicate that the user wants to receive the particular promotional material.

Park fails to teach or suggest that the promotion associated with the vehicle maintenance event is visually displayed for the user as recited in claim 7. The Examiner improperly asserts that the deficiency in *Mezger* is remedied by *Park*. *Mezger* and *Park*, taken individually, or in combination, fail to disclose, teach or suggest all of the limitations of claim 7. Therefore, claim 7 is patentable over the cited references.

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The Examiner fails to establish a prima facie case of obviousness for any of the rejected claims 1-11. This appeal should be granted and claims 1-11 should be allowed.

Respectfully submitted,
SNELL & WILMER L.L.P.

Dated: March 15, 2007

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VIII. CLAIMS APPENDIX

1. A method of targeting promotions to an individual associated with a vehicle, where the vehicle includes an on-board system including vehicle sensors from which a maintenance event can be detected, said method comprising:

detecting a vehicle maintenance event, including

digitally interrogating the on-board system of the vehicle,

detecting when the vehicle maintenance condition meets predetermined maintenance criteria, and

transmitting wirelessly to a remote computer an identification that the particular vehicle has met the predetermined maintenance criteria;

generating a promotion associated with the vehicle maintenance event; and

providing the promotion to the individual associated with the particular vehicle, including

using an association between the individual and the particular vehicle to associate the vehicle maintenance event with the individual, and

sending the promotion to the individual.

2. A method according to claim 1, wherein:

interrogating the on-board system includes providing a vehicle having an on-board digital system having instructions stored therein operative to cause the digital system to unsolicitedly detect occurrence of the maintenance event; and

said instructions further cause the on-board digital system and a wireless transmitter associated with the vehicle to unsolicitedly contact the remote computer and send the identification to the computer.

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3. A method according to claim 1, wherein generating a promotion includes:
 - obtaining service discount coupon permissions for a plurality of service providers, across multiple geographies;
 - filtering the service providers based on type of vehicle maintenance service and geographic vicinity to the individual; and
 - generating and transmitting at least one coupon to an address associated with the individual in response to the filtering.

4. A method according to claim 1, wherein generating a promotion includes:
 - generating a discount coupon for a product that is complimentary to the vehicle maintenance event; and
 - transmitting the coupon to an address associated with the individual.

5. A method according to claim 1, wherein generating a promotion includes:
 - generating a discount coupon for a service that is complimentary to a service for the vehicle maintenance event; and
 - transmitting the coupon to an address associated with the individual.

6. A method according to claim 1, wherein:
 - transmitting to a remote computer includes transmitting the identification to a delegatee of a vehicle manufacturer or dealer; and

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generating a promotion includes use of the identification by the delegatee to generate a notification that a particular vehicle maintenance event has been reached, and mailing that notification to the individual pursuant to a vehicle sales promotion.

7. A method according to claim 1, wherein:

the vehicle has an on-board computer system and a vehicle user display screen; and
sending the promotion to the individual includes sending an electronic message to the on-board computer system for the vehicle which causes the computer system to visually display the promotion for the user.

8. A method according to claim 1, wherein:

using an association includes storing contact information for the individual, including an email address associated with the individual; and
sending the promotion to the individual includes sending an electronic message to the user's email address.

9. A method according to claim 1, wherein generating a promotion includes:

generating a discount coupon for a product that is complimentary to a service for the vehicle maintenance event; and
transmitting the coupon to an address associated with the individual.

10. A method according to claim 1, wherein using an association includes:

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collecting, at the time of vehicle purchase, a contact address for a vehicle purchaser, and
storing the contact address in an electronic database.

11. A method according to claim 1, wherein using the association includes:
storing a vehicle identification number on-board the vehicle;
upon detection of a maintenance event, transmitting the vehicle identification number
together with the identification sent to the remote computer; and
associating contact information for the individual with a particular maintenance event
using the vehicle identification number.

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IX. EVIDENCE APPENDIX

No evidence to be submitted.

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X. RELATED PROCEEDINGS APPENDIX

No related proceedings.